

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Kotewicz *et al.*

Appl. No. 10/024,149

Filed: December 21, 2001

For: **Cloned Genes Encoding Reverse
Transcriptase Lacking RNase H
Activity**

Confirmation No. 4033

Art Unit: 1652

Examiner: *To Be Assigned*

Atty. Docket: 0942.049000A/RWE/MTT

Ninth Supplemental Information Disclosure Statement

Commissioner for Patents
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Ninth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Eighth Supplemental Information Disclosure Statement filed herewith in connection with the above-captioned application. All documents were cited and submitted to the Office in Application No. 09/220,330, filed December 24, 1998.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered. This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

Consideration of the cited documents and making the same of record in the prosecution of the above-identified application is respectfully requested.

Applicants note that document AT105 ("Clontech's Motion for Partial Summary Judgement of Invalidity (Claim Indefiniteness)") was filed by defendant Clontech together with a memorandum and a motion to file under seal the memorandum. In view of this motion, a copy of the memorandum is not being submitted herewith. The following summarizes Clontech's position as set forth in its memorandum.

Clontech alleges that the claims of U.S. Patent 6,063,608 ("the '608 patent") that recite "as shown in Fig. 5" are *per se* indefinite under 35 U.S.C. § 112, second paragraph, because the '608 patent contains Figs. 5A and 5B, but no Fig. 5.

Clontech alleges that interpreting the term "Fig. 5" to mean Figs. 5A and/or 5B renders the claims invalid, as Fig. 5B purports to be a representation of a gel assay of the wild type enzyme. According to Clontech, since the wild type enzyme is by definition prior art, if the claims cover Fig. 5B, they are anticipated.

Clontech also alleges that Fig. 5A is a composite from at least three sources. Dr. Gerard has testified that he would need to look at the original data in order to confirm whether the gel depicted in Fig. 5A is a composite. Further, Clontech alleges that Counsel

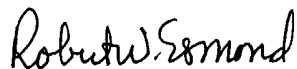
for Invitrogen Corporation (the Patent Owner) has confirmed that the original data has been lost. Clontech contents that these allegations require that the teaching of Fig. 5A is *per se* indefinite.

This Ninth Supplemental Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. Thus, no statement or fee is required.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: March 5, 2003

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FORM PTO-1449 NINTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				ATTY. DOCKET NO. 0942.049000A/RWE/MTT		APPLICATION NO. 10/024,149	
				APPLICANTS Kotewicz et al.			
				FILING DATE December 21, 2001		GROUP 1652	

U.S. PATENT DOCUMENTS							
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FOREIGN PATENT DOCUMENTS							
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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR		
	AS	100	"Complaint," dated January 8, 2001, from Invitrogen Corporation v. New England Biolabs, Inc., U.S. District Court, District of Massachusetts, Civil Action No. 01 CV 10038 WGY
	AT	100	"Complaint," dated February 15, 2001, from Invitrogen Corporation v. Display Systems Biotech, Inc., U.S. District Court, Southern District of California

EXAMINER	DATE CONSIDERED
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	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>101</u>	"Stratagene's Memorandum in Opposition to Invitrogen's Motion for Preliminary Injunction and Memorandum in Support of Stratagene's Motion for Leave to File an Additional Brief in Opposition to LTI's Motion for Preliminary Injunction..." dated February 27, 2001, with attached Exhibits A-N, from <i>Invitrogen Corporation v. Stratagene Holding Corp., Stratagene, Inc., and Biocrest Manufacturing, L.P.</i> , U.S. District Court, District of Delaware, Civil Action No. 00-620 (JJF)
	AS	<u>101</u>	"Clontech's Reply in Support of Its Motion for Summary Judgment of Invalidity (Claim Indefiniteness) and in the Alternative for a Claim Construction, and Clontech's Opposition to Invitrogen's Cross-Motion for Summary Judgement," dated March 14, 2001, with attached Exhibits I and J, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AT	<u>101</u>	"Order" and attached "Memorandum Opinion," dated May 4, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879

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OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>102</u>	"Clontech's Notice Pursuant to 35 U.S.C. § 282," dated May 10, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AS	<u>102</u>	"Order" and attached "Memorandum Opinion," dated May 22, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AT	<u>102</u>	"Clontech's Supplemental Pretrial Order," dated May 25, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action No. AW 00-1879 (consolidated w/AW 96-4080)

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	AR	<u>103</u>	"Order" dated May 25, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AS	<u>103</u>	"Responsive Expert Statement of Joseph O. Falkinham, III," dated May 31, 2001, from <i>Clontech Laboratories, Inc. v. Life Technologies, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action No. AW 00-1879
	AT	<u>103</u>	"Order" and attached "Memorandum Opinion," dated July 6, 2001, from <i>Invitrogen Corporation v. Stratagene Holding Corp. et al.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action No. AW 01-1168

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	AR	104	"Report and Recommendation Regarding Clarification of the Court's Orders Dated May 4, 2001 and May 24, 2001," dated August 8, 2001, from Invitrogen Corporation v. Clontech Laboratories, Inc., U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AS	104	"Defendant Clontech Laboratories, Inc.'s Objections to the Special Master's Report and Recommendation Regarding Clarification of the Court's Orders Dated May 4, 2001 and May 24, 2001," dated August 17, 2001, from Invitrogen Corporation v. Clontech Laboratories, Inc., U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AT	104	"Invitrogen Corporation's Objections to the Special Master's Report and Recommendation Regarding Clarification of the Court's Orders Dated May 4, 2001 and May 24, 2001," dated August 22, 2001, from Invitrogen Corporation v. Clontech Laboratories, Inc., U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879

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	AR	<u>105</u>	"Defendant Clontech Laboratories, Inc.'s Response to Plaintiff Invitrogen Corporation's Objections to the Special Master's Report and Recommendation Regarding Clarification of the Court's Orders Dated May 4, 2001 and May 24, 2001," dated August 31, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AS	<u>105</u>	"Complaint for Patent Infringement and Inducement to Infringe," dated September 6, 2001, from <i>Invitrogen Corporation v. Toyobo Co., Ltd.</i> , U.S. District Court, Southern District of California, Civil Action No. 01 CV 1628 W (JFS)
	AT	<u>105</u>	"Clontech's Motion for Partial Summary Judgment of Invalidity (Claim Indefiniteness)," dated September 27, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879

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	AR	<u>106</u>	"Brief of Defendants-Appellees," dated October 5, 2001, from <i>Invitrogen Corporation v. Stratagene Holding Corp., Stratagene, Inc., and Biocrest Manufacturing, L.P.</i> , U.S. Court of Appeals for the Federal Circuit, Civil Action No. AW-01-1168
	AS	<u>106</u>	"Order," dated October 5, 2001, from <i>Invitrogen Corporation v. Clontech Laboratories, Inc.</i> , U.S. District Court, District of Maryland, Southern Division, Civil Action Nos. AW 96-4080 and AW 00-1879
	AT	<u>106</u>	"Complaint," dated October 17, 2001, from <i>Invitrogen Corporation v. Incyte Genomics, Inc.</i> , U.S. District Court, District of Delaware, Civil Action No. 01-692

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	AR	<u>107</u>	"Rebuttal Expert Statement of Joseph O. Falkinham, III," from <i>Clontech Laboratories, Inc. v. Life Technologies, Inc.</i> , U.S. District Court, District of Delaware, Civil Action No. 98-750 (SLR)
	AS	<u>107</u>	"Expert Statement of Joseph O. Falkinham, III," with attached Exhibits 1-3, from <i>Clontech Laboratories, Inc. v. Life Technologies, Inc.</i> , U.S. District Court, District of Delaware, Civil Action No. 98-750 (SLR)
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